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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,407	04/02/2007	Danilo Molteni	1029.1033	1405

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EXAMINER	
MUSLEH, MOHAMAD A	
ART UNIT	PAPER NUMBER
2832	
MAIL DATE	DELIVERY MODE
10/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/577,407	MOLTENI, DANILO	
	Examiner	Art Unit	
	MOHAMAD A. MUSLEH	2832	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 July 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 1/3-8** are rejected under **35 U.S.C. 102(e)** as being anticipated by **Gleckner US 6,850,140 B1[Gleckner]**.

2. Regarding **claim1**, at **[figs. 1-5c] Gleckner** teaches a ferromagnetic member **[11]** for the circuit connection between at least two magnetic poles **[12/14]**, characterized in that each magnetic pole **[12/14]** is made up of ferrite magnets **[12]** in the bottom portion **[fig. 2]** in contact with the ferromagnetic member **[11]** for the circuit connection, and of rare earth magnets **[14]** in the top portion that represents the entrance/exit surface **[fig. 2]** of the magnetic flux lines.

3. Regarding **claim 3**, at **[fig. 4] Gleckner** teaches a ferromagnetic cylinder **[26]** around which there are applied the magnetic poles **[12/14]**, the cylinder **[26]** being enclosed by a protective casing **[30]** of non-magnetic material **[c. 6, l. 44-48]** filled with a blocking resin **[c. 5, l. 8-21]**, this assembly being secured onto a shaft **[28]** so that it can be used for a conveyor on which the material to be treated is drawn **[c. 1, l. 20-29]**.

4. Regarding **claims 4/6**, the ferrite magnets **[12]** are made of barium ferrite or strontium ferrite **[c. 4, l. 38-48]**.

5. Regarding **claims 5/7/8**, characterized in that the rare earth magnets are made of samarium-cobalt or iron-boron-neodymium **[c. 4, l. 49-57]**.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. **Claims 2/9** are rejected under **35 U.S.C. 103(a)** as being unpatentable over **Gleckner**.

7. Regarding **claims 2/9**, **Gleckner** discloses the claimed invention except for that in each magnetic pole **[12/14] the ratio** between the effective magnetic length of the ferrite magnets **[12]** and of the rare earth magnets **[14]** is **between 1:1 and 3:1**, or **2:1**. At **[c. 5, l. 54-64] Gleckner** discloses that "...the ratio of the thickness of the layer of ferritic magnet to the rare earth magnet is preferably between 1:3 and 1:5, and even more preferably 1:3...". It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the ratio between 1:1 and 3:1, since the prior art disclosed some measurements for increasing the magnetic field, and it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Response to Arguments

8. Applicant's arguments filed **07/15/2008** have been fully considered but they are not persuasive.

9. In response to applicant's argument that **Gleckner** does not teach or suggest a magnetic separator with permanent magnets. The examiner disagrees for two reasons:

a. A recitation of the intended use of the claimed invention must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, **then it meets the claim**.

b. The recitation **[magnetic separator with permanent magnets]** has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand-alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

10. In response to applicant's argument that **Gleckner** does not teach or suggest a ferromagnetic member for a circuit connection between at least two magnetic poles, and **Gleckner** does not teach or suggest ferrite magnets in the bottom portion in contact with a ferromagnetic member, and rare earth magnets in the top portion for an entrance/exit surface of magnetic flux lines. The examiner disagrees, and remind the

applicant of the definition of a pole, a pole could mean **[either of two regions of a magnet, designated north and south, where the magnetic field is strongest]**, moreover, the examiner asks the applicant to further view **[c. 5, l. 26-35]**, wherein the prior art teaches that layered **magnets 10** may include at least one additional **layer 11** of **magnetic material**. The additional **layer 11** may be superposed upon the rare earth **magnet 14** or disposed between the rare earth **magnet 14** and the ferrite **magnet 12**, which means that the **magnets 12/14** are connected to a magnetic material for completing the magnetic circuit, therefore the examiner believes that the reference teachings meet the claim.

11. In response to applicant's argument that **Gleckner** does not teach or suggest a protective casing filled with a blocking resin. The examiner disagrees and asks the applicant to view **claims' three** rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MOHAMAD A. MUSLEH** whose telephone number is **((571)272-9086**. The examiner can normally be reached on M-F (8:30-5:00 Est. Time) 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Elvin G. Enad** can be reached on **(571) 272-1990**. The fax phone number for the organization where this application or proceeding is assigned is **(571) 273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval **(PAIR)** system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see **http://pair-direct.uspto.gov**. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center **(EBC) at 866-217-9197 (toll-free)**. If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call **800-786-9199 (IN USA OR CANADA) or 571-272-1000**.

/Mohamad A Musleh/
Examiner, Art Unit 2832

/Elvin G Enad/
Supervisory Patent Examiner, Art Unit 2832